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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,658	04/20/2006	Toshifumi Kawamura	4700.P0329US	5732

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FLYNN THIEL BOUTELL & TANIS, P.C.
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EXAMINER

BAREFORD, KATHERINE A

ART UNIT	PAPER NUMBER
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1792

MAIL DATE	DELIVERY MODE
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02/24/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<p align="center">Advisory Action Before the Filing of an Appeal Brief</p>	<p>Application No. 10/576,658</p>	<p>Applicant(s) KAWAMURA ET AL.</p>	
	<p>Examiner Katherine A. Bareford</p>	<p>Art Unit 1792</p>	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 01 February 2010 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 2 and 5-13.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Katherine A. Bareford/
Primary Examiner, Art Unit 1792

Continuation of 11. does NOT place the application in condition for allowance because: (A) As to the 35 USC 103 rejections of the claims, applicant argues that '067 provides no suggestion that the azole based silane coupling agent would be suitable in an ink composition as in '479, however, the Examiner disagrees. As discussed in the Final Rejection of 10/29/09, the Examiner has taken the position that it would be obvious to replace the silane coupling agent of '479 with the silane coupling agent of '067 in the ink jet composition. It would have been obvious to optimize amounts and conditions to use in an ink jet process, given that '479 provides the use of silane coupling agents in general and to adjust the viscosity of the solution for performing the printing (paragraph [0023]), clearly indicating to optimize amounts and conditions to use in the ink jet process, since '479 teaches using a set amount of material with a controlled viscosity to provide ink jet printing (paragraph [0044]). The Examiner also notes the further optional use of the references to Mardilovich or Furusawa as to the suggestion to optimize conditions to provide ink jet printing. As to applicant's arguments regarding heating of the silane coupling agent and heating of the plating solution, these features are not prevented by the claims as worded -- the claims do not require not heating the plating solution or substrate. As to the argument that '479 and '067 have different results from plating with the gamma-aminopropyl triethoxysilane -- the Examiner notes that the Example of '479 and comparative Example 3 of '067 are not exactly the same, which may affect results, with the example of '479 using a plastic substrate (paragraph [0041]) as opposed to glass, a material of KBE90 as opposed to KBE-903, post heating of the substrate in '479 before plating to 150 degrees C, while '067 describes heating to 105 degrees C. As to the cited section of '067 being erroneous, applicant has not made a showing as to this issue. Reference to WO A12000001862 does not mean that this is correct and as well this reference is in Japanese. Finally, the indication that the plating using the gamma-aminopropyl triethoxysilane is defective in some cases would provide more motivation to use a different silane as suggested by '067. As to benefits from using the claimed azole based silane, the Examiner notes that one is already suggested to use the azole based silane from the combination of references with an expectation of improved result from the better dissolvability and plating rate. "The fact that appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious." *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985) (The prior art taught combustion fluid analyzers which used labyrinth heaters to maintain the samples at a uniform temperature. Although appellant showed an unexpectedly shorter response time was obtained when a labyrinth heater was employed, the Board held this advantage would flow naturally from following the suggestion of the prior art.) (B) As to the outstanding double patenting and provisional double patenting rejections, applicant argues that none of the references disclose that an azole based silane coupling agent can be used in an ink jet composition which is applied to the substrate by ink jet printing, and the references are no more relevant than '067, and '479 only discloses a silane coupling agent, but does not disclose the unexpected benefits of the azole based silane coupling agent. The Examiner notes these arguments, however, the double patenting rejections use the combination of both '479 and '067 and the combination of these references with the cited patents/co-pending application provides the suggestion to use the azole based silane coupling agent in the ink jet composition for the same reasons as discussed with regard to section (A) above, and the test results do not overcome the rejections for the reasons as discussed in section (A) above, as the suggestion to combine for the benefit of improved results is already provided..